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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,130	08/30/2000	Kent Malmgren	1010315-000092	1064

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BUCHANAN, INGERSOLL & ROONEY PC  
POST OFFICE BOX 1404  
ALEXANDRIA, VA 22313-1404

EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/651,130

Applicant(s)

MALMGREN ET AL.

Examiner

Victor S. Chang

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,2,4-13,15 and 20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

***NOTE***

1. Applicants argue at Remarks pages 3-4 that the Office simply mixed and matched steps from throughout the specification of Chen, and the Office has provided no guidance, absent improper hindsight reconstruction, why one skilled in the art would mix and match the steps as suggested; further, these steps are very generic and broadly stated, and lacks precise manner, timing, amounts, temperatures, concentrations, etc., hence there are too many unknowns and variables to be adjusted and Chen products do not necessarily possess the presently claimed characteristics. However, applicants are reminded that none of the process details are being claimed. Further, applicants appear to have agreed that Chen teaches all the process limitations required for making the products, there is no reason to believe that one skilled in the art would not be able to make a product made by the Chen's process in the choice of an improved absorbing properties. Applicants' attempt to analyze the Chen's disclosure in a vacuum and ignoring the skill of the art to optimize the process limitations are unpersuasive. Further, even if the product-by-process limitations are claimed, since the patentability of a product by process claim is determined based on the product itself, not the process, and the process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art, and applicants have failed to provide any such evidence.

Applicants argue at pages 5-6 that the Office's optimization conclusion was based on the assumption that absorption properties are traditional result-effective variables, however the present invention characterizes properties obtained from conflicting process parameters, which have competing impacts, hence the properties are not traditional result-effect variables.

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However, while Chen is silent about the specific terms to characterize the properties claimed, since Chen teaches essentially the same structure and composition as the instant invention, and for the same end use, the un-traditional characterization of the properties are considered to be inherent.

Applicants argue at pages 7-9 that gel liquid is a liquid that is different form of storage from capillary liquid, and gel liquid is firmly bound in cells by the swelling walls, which stays with the absorbent product after centrifugation. However, applicants are reminded that the definition in the specification states that “Gel liquid refers to liquid held in pores smaller than 3 mm and capillary liquid refers to loosely bound liquid in pores larger than 3 mm and up to 500 mm” [specification, page 5, second paragraph from the bottom]. Clearly, they are merely liquids of the same composition being absorbed in pores of different ranges of sizes. Since Chen’s invention article anticipates all the structure and composition limitations as claimed, in particular, the Chen teaches progressive smaller pore sizes as claimed, Chen’s product is inherently capable of absorbing both the capillary liquid and gel liquid. Finally, even if “gel liquid” is redefined as swelling liquid in the cell walls, since Chen’s invention anticipates all the structure and composition limitations as claimed, including the cell walls, it is not seen that, upon liquid absorption, why “gel liquid” is not inherently present in Chen’s product.

Applicants argue at page 9 that the Office ignores that by relying upon Chen’s teachings one skilled in the art would be directed to optimizing the capillary absorption alone, and there is no motivation to obtain a product as claimed. However, since Chen teaches the same liquid absorbing material for making the absorbent product as the instant invention, its “gel liquid” absorbing property is inherently disclosed, and a suitable total liquid absorption by the “gel

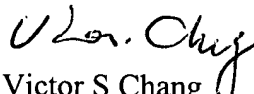
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liquid" absorbing material and capillary liquid among the pores are either anticipated, or an obvious routine optimization to one skilled in the art. It is not seen that how one skilled in the art would not have recognized that Chen has selected a liquid absorbing material to make the product.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Victor S Chang  
Examiner  
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12/1/2006